

## REMARKS

Reconsideration of this application as amended is respectfully requested.

In the Office Action dated June 28, 2002, claims 1-31 and 96-100 were pending. Drawings were objected to as failing to complying with 37 CFR 1.84(p)(5) because they did not include the reference numbers mentioned in the description. Claims 6-10 and 25-31 were rejected under 35 U.S.C. 112, second paragraph. Claims 1-24 and 96-100 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lawlor et al. (U.S. Patent No. 5,870,724) in view of Halliburton (U.S. Patent No. 5,025,139). Claims 25-31 would be allowable if rewritten to overcome the rejections under 35 U.S.C. 112, second paragraph.

In this response, no claim has been cancelled, and thus claims 1-31 and 96-100 remain pending. Claims 1, 6, 11-13, 17-19, and 25-31 have been amended. No new matter has been added.

## Drawings

The drawings were objected to because lack of reference numbers mentioned in the description. In this amendment, Applicant has submitted proposed drawings corrections in which corresponding reference numbers have been added conforming to the Examiner's request and no new matter has been added. The formal drawings will be submitted when the application is allowed.

### Claims Rejections - 35 U.S.C. §112

Claims 6-10 and 25-31 were rejected under 35 U.S.C. 112, second paragraph. In this response, claims 6 and 25-31 have been amended to overcome the rejections. Withdrawal of the rejections is respectfully requested.

### Rejections Under 35 U.S.C. §103(a)

Claims 1-24 and 96-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawlor in view of Halliburton.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (Manual of Patent Examining Procedure (MPEP) ¶ 2143.03).

Applicant submits that claims 1-24 and 96-100 of the present application includes limitations not disclosed or taught by Lawlor and Halliburton, individually or in combination. As a result, claims 1-24 and 96-100 are patentable over Lawlor in view of Halliburton.

Specifically, independent claim 1 recites as follow:

1. (Amended) A self-targeting coupon comprising:
  - a first field comprising at least one question and a response area, wherein the response area includes one or more responses, each of the one or more responses being on a removable concealer; and
  - one or more additional fields concealed by removable concealers, wherein selection of one of the one or more responses by an individual in response to the at least one question instantaneously reveals information referring to the one or more fields concealed by the removable concealers. (emphasis added)

Independent claim 1 includes a limitation of “wherein selection of one of the one or more responses by an individual in response to the at least one question instantaneously reveals information referring to the one or more fields concealed by the removable concealers”, which is absent from either Lawlor or Halliburton, individually or in combination. Rather, Lawlor discloses a remote distribution of financial services (e.g., home banking and bill-paying) involves distributing portable terminals to a user base (see, Abstract). Nowhere in Lawlor discloses scoring or targeting a coupon of a user. Applicant submits that it would not be obvious to one with ordinary skill in the art to use the teachings of Lawlor to conceive the present invention as claimed.

In the Office Action, the Examiner stated:

Lawlor et al. Teaches (independent claims 1, 14 and 96) a method of delivering and targeting an advertisement, and an advertisement so delivered and targeted, the method comprising: selecting a response (e.g., identifying the user) in a first field (col. 25 lines 5-10 and col. 30 lines 47-50), which is any of the four fields taught (col. 23 lines 44-54), including at least one request (col. 30 lines 47-53) and at least one response, respectively on backlit LED and on LCD screens (col. 24 lines 39-56 and col. 23 lines 34-41), which reads on “on top of a removable concealer”; *microcontroller 116* executing program control instructions in response to the selection of a response in the first field (i.e., depressing *input controls 104-114*. col. 27 lines 56-58 and Fig. 4), producing a request to identify the *bank account* (col. 30 lines 51-3), which reads on removing the removable concealer to reveal information (the request for *bank account*) indicating an area of a second field (*input controls 104-114* corresponding to one of the four LCD fields where the *bank account* request appears) to select; *microcontroller 116* again executing program control instructions in response to the selection of a response in the second field (i.e., depressing *input controls 104-114*. col. 27 lines 56-58 and Fig. 4), producing a request to enter an ATM PIN (col. 30 lines 56-59), which reads on revealing information by removing additional removable concealer from the indicated area of the second field.

(6/28/2002 Office Action pp. 3)

Applicant respectfully disagrees. Lawlor discloses a system for remote distribution of financial services (e.g., home banking and bill payment) involving

distributing portable terminals to a user base (see, Abstract). Nowhere in Lawlor discloses, suggests or teaches targeting or scoring a coupon.

In contrast, the present invention as claimed relates to target and score a coupon designated to a specific group of users. The coupon is scored based on the selections of an individual in response to one or more questions. The information revealed is subject to which response the individual selects. As a result, a coupon is presented to the individual based on the information or responses provided by the individual. Thus, the coupon matches the specific tastes of the individual. Applicant submits that a person with ordinary skill in the art would not apply the teachings of Lawlor to score and evaluate a coupon.

Halliburton discloses a redeemable coupon disbursement control and reporting system especially for an ATM machine. Contrary to the present invention as claimed, the coupons are preprinted on the back of ATM receipts (see, col. 4, lines 1 to 21). There is no evaluation or scoring on the coupons based on a user's responses. It appears that Halliburton teaches away from, instead of towards to, the present invention as claimed. Applicant submits that one with ordinary skill in the art would not combine Halliburton with Lawlor because of lack of motivation. There is no need to score or evaluate the coupons preprinted on the back of the ATM machine receipts. A user of an ATM machine would not have options to respond to a variety of questions related to a coupon. Rather, the user of ATM machine only responds to items related to the corresponding financial institute. Nowhere in Halliburton suggests to combine with Lawlor and nowhere in Lawlor suggests to combine with Halliburton. Applicant submits that it would be impermissible to use hindsight to find the motivation to combine references by using an Applicant's own teachings against that Applicant.

Furthermore, even if, for the sake of the arguments, Halliburton is combined with Lawlor, such combination still lacks the limitation of “wherein selection of one of the one or more responses by an individual in response to the at least one question instantaneously reveals information referring to the one or more fields concealed by the removable concealers”. Lawlor stated:

Central computer 52 would control the “Select One” prompt to be illuminated (as showed in FIG. 3C) when the user is to select one of several alternatives displayed on display 102. Typically, the user responds by making a selection—that is, by depressing the one of “soft” (i.e., programmable) keys 108 which points to the line of the display on which the option be desired is displayed.

The “Change Screen” prompt (see FIG. 3D) is typically illuminated when the NEXT key 106 is to be depressed (e.g., to confirm a previously entered request, and/or move on to the next screen in a sequence of screen. (col. 25, lines 4 to 14)

It appears that Lawlor includes at least two screens: a first screen to receive user’s inputs, such as PIN number, and a second screen is displayed when the user explicitly presses the “next” button. Applicant submits that Lawlor does not include “one or more additional fields concealed by removable concealers” when a first field is displayed. In addition, Lawlor fails to disclose that “selection of one of the one or more responses by an individual in response to the at least one question instantaneously reveals information referring to the one or more fields concealed by the removable concealers”.

Therefore, in view of the arguments set forth, independent claim 1 is not obvious in view of Halliburton and Lawlor and is patentable over Halliburton in view of Lawlor. Independent claims 14 and 96 include similar limitations discussed above. Thus, for the reasons similar to those discussed above, claims 14 and 96 are patentable over Halliburton in view of Lawlor.

The rest of the claims depend from one of the above independent claims, thus include all of the distinct features of the respective independent claim, and therefore, for the reasons similar to those discussed above, are patentable over Halliburton in view of Lawlor.

CONCLUSION

In view of the foregoing, Applicant respectfully submits the present application is now in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call the undersigned attorney at (408) 720-8300.


Applicant hereby petitions for an extension of time to respond to the pending Office Action, and a check for the extension fee is enclosed.

Please charge Deposit Account No. 02-2666 for any shortage of fees in connection with this response.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Date: 11/26, 2002

  
\_\_\_\_\_  
Kevin G. Shao  
Reg. No. 45,095

12400 Wilshire Boulevard  
Seventh Floor  
Los Angeles, California 90025-1026  
(408) 720-8300

VERSION WITH MARKINGS TO SHOW CHANGES MADE

Please amend claims 1, 6, 11-13, 17-19, and 25-31 as indicated below.

1. (Amended) A self-targeting coupon comprising:

a first field comprising at least one question and a response area, wherein the response area includes one or more responses, each of the one or more responses being on removable concealer; and

one or more additional fields concealed by removable concealer, wherein selection of one of the one or more responses by [a] an individual in response to the at least one question instantaneously reveals information referring to the one or more additional fields concealed by the removable concealer.

6. (Amended) The self-targeting coupon of claim 4 wherein the one or more areas of the [second field] one or more additional fields are covered with removable concealer.

11. (Amended)       The self-targeting coupon of claim 1 wherein the at least one question comprises a plurality of questions, each of the plurality of questions associated with a distinct set of responses in the response area, each response in each of responses being on a removable concealer, wherein [a] an individual selects one response in each set of responses by removing the removable concealer thereon to reveal the information to determine an area of the [second field] one or more additional fields to select.

12. (Amended)       The self-targeting coupon of claim 11 wherein the plurality of responses to the plurality of questions indicates [a] an individual preference.



13. (Amended) The self-targeting coupon of claim 11 wherein information under the removable concealer of more than one of the plurality of responses to the plurality of questions is required to determine an area of the [second field] one or more additional fields to select.

17. (Amended) The method of targeting a coupon of claim 14 wherein revealing information includes revealing a value to [a] an individual.

18. (Amended) The method of targeting a coupon of claim 14 wherein revealing information includes revealing a direction to [a] an individual.

19. (Amended) The method of targeting a coupon of claim 14 wherein revealing information includes revealing a symbol to [a] an individual.

25. (Amended) A method of [scoring] grading a coupon comprising:  
scanning a coupon including a first field having at least one question and at least one answer on top of a removable concealer and a second field;  
ensuring that a predetermined number of answers corresponding to the number of questions in the first field is selected in the first field by removal of the removable concealer; and  
ensuring that only a predetermined number of areas is selected by removal of removable concealer in the second field.

26. (Amended) The method of [scoring] grading a coupon of claim 25 further comprising:  
ensuring that the area selected in the second field is indicated by the information revealed by the removal of the removable concealer in the first field.

27. (Amended)        The method of [scoring] grading a coupon of claim 25 further comprising:

ensuring that the area selected in the second field is NOT indicated by the information revealed by the removal of the removable concealer in the first field.

28. (Amended)        The method of [scoring] grading a coupon of claim 25 further comprising:

characterizing the coupon by information revealed by the removal of removable concealer in the second field.

29. (Amended)        The method of [scoring] grading a coupon of claim 28 wherein characterizing the coupon further comprises:

assigning a value to the coupon based on information revealed by the removal of removable concealer in the second field.

30. (Amended)        The method of [scoring] grading a coupon of claim 28 wherein characterizing the coupon further comprises:

assigning a quantity to the coupon based on information revealed by the removal of removable concealer in the second field.

31. (Amended)        The method of [scoring] grading a coupon of claim 28 wherein characterizing the coupon further comprises:

assigning a free item to the coupon based on information revealed by the removal of removable concealer in the second field.

32. – 95. (Cancelled)